

REMARKS

Upon entry of the foregoing amendment, claims 1-48 are pending in the present application. Claims 22-31 have been withdrawn from consideration by the Examiner. Claims 1, 32, 39, 40, 42, and 43 have been amended, and dependent claims 47 and 48 have been newly added. In view of the foregoing amendment and the following remarks, Applicants respectfully request allowance of the pending claims.

(A) Interview Request

Applicants are submitting herewith an Applicant initiated interview request form (PTOL-413A) to request an interview prior to examination of the foregoing claims. Accordingly, Applicants respectfully request that the Examiner contact the undersigned to arrange an interview prior to examining the present amendment and RCE.

(B) Rejections under 35 U.S.C. 102

1 Hagemeyer et al. (U.S. 4,573,287)

In the Office Action of August 7, 2007, the Examiner rejected claims 1-3, 5-8, 10-17, 20, 21, 32-36, 38, and 39 under 102(b) as anticipated by U.S. Patent No. 4,573,287 to Hagemeyer et al. Specifically, the Examiner applied two different interpretations of Hagemeyer et al. for independent claims 1 and 32. Applicants respectfully request reconsideration of these claims based on the following points.

a) Claims 1-3, 5-8, 10-17, 20, 21, and 39

Applicants have amended independent claim 1 to clarify the subject matter being claimed. More specifically, Applicants respectfully submit that Hagemeyer et al. does not anticipate independent claim 1, as presently recited, because Hagemeyer et al. fails to disclose, teach, or suggest:

- 1) “a side portion extending between the exterior portion and the interior portion disposed opposite the outer edge of the passive door ...,” as presently recited;
- 2) “a spacer extending outwardly from a major surface of the side portion,” as presently recited; and

- 3) “an interior flange extending away from where said interior portion meets said side portion to engage the interior surface of the passive door, and an exterior flange opposite said interior flange and extending away from where said exterior portion meets said side portion to engage the exterior surface of the passive door,” as presently recited.

Because there is no interpretation of Hagemeyer et al. that reads on independent claim 1, as presently recited, and Hagemeyer et al. does not disclose the features listed above, Hagemeyer et al. cannot possibly anticipate independent claim 1.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as contained in the...claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). “The elements must be arranged as required by the claim...” In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Further, in the event that the Office Action is relying on the theory of inherency in any manner, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). See also MPEP 2112.

Accordingly, since Hagemeyer et al. does not explicitly or inherently show every element as presently recited in independent claim 1, Hagemeyer et al. cannot be properly used to reject independent claim 1 under 35 U.S.C. § 102. Therefore, it is respectfully submitted that independent claim 1 is allowable over Hagemeyer et al., and withdrawal of this rejection is earnestly solicited.

Regarding claims 2-3, 5-8, 10-17, 21, and 39, it is respectfully submitted that for at least the reason that claims 2-3, 5-8, 10-17, 21, and 39 depend from independent claim 1, and therefore contain each of the features as presently recited in this claim, claims 2-3, 5-8, 10-17, 21, and 39 are therefore also patentable over Hagemeyer et al., and withdrawal of the rejection of these claims is also earnestly solicited.

b) Claims 32-36 and 38

Applicants have amended independent claim 32 to clarify the subject matter being claimed. More specifically, Applicants respectfully submit that Hagemeyer et al. does not anticipate independent claim 32, as presently recited, because Hagemeyer et al. fails to disclose, teach, or suggest:

- 1) “an interior flange extending from the second side of said interior portion opposite from and substantially parallel to said exterior flange,” as presently recited;
- 2) “a side portion extending between where the exterior portion meets said exterior flange and where the interior portion meets said interior flange...,” as presently recited; and
- 3) “said side portion having ... a spacer extending outwardly from a surface thereof,” as presently recited.

Because there is no interpretation of Hagemeyer et al. that reads on independent claim 32, as presently recited, and Hagemeyer et al. does not disclose the features listed above, Hagemeyer et al. cannot possibly anticipate independent claim 32. Therefore, it is respectfully submitted that independent claim 32 is allowable over Hagemeyer et al., and withdrawal of this rejection is earnestly solicited.

Regarding claims 33-36 and 38, it is respectfully submitted that for at least the reason that claims 33-36 and 38 depend from independent claim 32, and therefore contain each of the features as presently recited in this claim, claims 33-36 and 38 are therefore also patentable over Hagemeyer et al., and withdrawal of the rejection of these claims is also earnestly solicited.

2 *Wendt (U.S. 4,281,480)*

In the Office Action of August 7, 2007, the Examiner rejected claims 1, 40, 41, and 46 under 102(b) as anticipated by U.S. Patent No. 4,281,480 to Wendt. Applicants respectfully request reconsideration of these claims based on the following points.

a) Claim 1

Applicants have amended independent claim 1 to clarify the subject matter being claimed. More specifically, Applicants respectfully submit that Wendt does not anticipate independent claim 1, as presently recited, because Wendt fails to disclose, teach, or suggest:

- 1) “an interior flange extending away from where said interior portion meets said side portion to engage the interior surface of the passive door...,” as presently recited;
- 2) “an exterior flange opposite said interior flange and extending away from where said exterior portion meets said side portion to engage the exterior surface of the passive door...” as presently recited; and
- 3) “a spacer ... having a distal end to maintain an air gap between a surface of the outer edge of the passive door and the side portion of the metallic rail when the astragal assembly is affixed thereto ...,” as presently recited.

Because there is no interpretation of Wendt that reads on independent claim 1, as presently recited, and Wendt does not disclose the features listed above, Wendt cannot possibly anticipate independent claim 1. Therefore, it is respectfully submitted that independent claim 1 is allowable over Wendt, and withdrawal of this rejection is earnestly solicited.

b) Claims 40, 41, and 46

Applicants have amended independent claim 40 to clarify the subject matter being claimed. More specifically, Applicants respectfully submit that Wendt does not anticipate independent claim 40, as presently recited, because Wendt fails to disclose, teach, or suggest:

- 1) “an interior flange extending from where said interior portion meets said side portion to engage the interior surface of the passive door...,” as presently recited;
- 2) “an exterior flange extending from where said exterior portion meets said side portion to engage the exterior surface of the passive door,” as presently recited; and

- 3) “the interior and exterior flanges spaced apart to accommodate an outer edge of the passive door therebetween,” as presently recited.

Because there is no interpretation of Wendt that reads on independent claim 40, as presently recited, and Wendt does not disclose the features listed above, Wendt cannot possibly anticipate independent claim 40. Therefore, it is respectfully submitted that independent claim 40 is allowable over Wendt, and withdrawal of this rejection is earnestly solicited.

Regarding claims 41 and 46, it is respectfully submitted that for at least the reason that claims 33-36 and 38 depend from independent claim 40, and therefore contain each of the features as presently recited in this claim, claims 41 and 46 are therefore also patentable over Wendt, and withdrawal of the rejection of these claims is also earnestly solicited.

3 *Clancy (U.S. 4,594,812)*

In the Office Action of August 7, 2007, the Examiner rejected claims 42-45 under 102(b) as anticipated by U.S. Patent No. 4,594,812 to Clancy et al. Applicants respectfully request reconsideration of these claims based on the following points.

Applicants have amended independent claim 42 to clarify the subject matter being claimed. More specifically, Applicants respectfully submit that Clancy et al. does not anticipate independent claim 42, as presently recited, because Clancy et al. fails to disclose, teach, or suggest:

- 1) “a door stop extending from the exterior portion of the frame on the opposite side from where the exterior flange is located, said door stop engaging the active door when the astragal assembly is attached to the passive door,” as presently recited;
- 2) “a side portion extending between the interior portion and the exterior portion opposite to the outer end of the passive door when the astragal assembly is attached thereto” as presently recited;

- 3) “an interior flange extending from where the interior portion meets the side portion to engage the interior surface of the passive door when the astragal assembly is attached thereto,” as presently recited; and
- 4) “an exterior flange extending from where the exterior portion meets the side portion to engage the exterior surface of the passive door when the astragal assembly is attached thereto,” as presently recited.

Because there is no interpretation of Clancy et al. that reads on independent claim 42, as presently recited, and Clancy et al. does not disclose the features listed above, Clancy et al. cannot possibly anticipate independent claim 42. Therefore, it is respectfully submitted that independent claim 42 is allowable over Clancy et al., and withdrawal of this rejection is earnestly solicited.

Regarding claims 43-45, it is respectfully submitted that for at least the reason that claims 43-45 depend from independent claim 42, and therefore contain each of the features as presently recited in this claim, claims 43-45 are therefore also patentable over Clancy et al., and withdrawal of the rejection of these claims is also earnestly solicited.

(C) Rejections under 35 U.S.C. 103

Claims 4, 9, 18, 19, and 37 have been rejected in view of various hypothetical combinations of secondary patent references with Wendt or Hagemeyer et al., as previously applied against independent claims 1 and 32. However, Applicants respectfully submit that even if these various combinations are assumed to be proper, the references being relied on by the Examiner, either alone or in combination with one another, fail to disclose, teach, or suggest all the features of independent claims 1 and 32, as discussed above. Specifically, neither Hagemeyer et al. nor Wendt teach or suggest each of the features of the independent claims 1, 32, 40, and 42. Because these references fail to teach the features of the independent claims, as discussed above, these primary references either alone or in combination with the secondary references applied by the Examiner in the obviousness rejection, necessarily fail to teach or suggest the features of claims 4, 9, 18, 19, and 37. Therefore, these claims are not rendered obvious

and are also patentable over the references of record, at least, by virtue of their dependency.


(D) Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

A fee of \$100 for additional claims has been incurred by this Amendment. If any further fees are required in connection with the filing of this amendment, please charge the same to our Deposit Account debit Account 50-0548.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'D. Valencia', written over a horizontal line.

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